



09 AUG 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Baker Botts L.L.P.
30 Rockefeller Plaza
New York, NY 10112-4498

In re Application of PAEK et al :
U.S. Application No.: 09/831,218 :
PCT Application No.: PCT/US99/26126 :
Int. Filing Date: 05 November 1999 : DECISION
Priority Date Claimed: 06 November 1998 :
Attorney Docket No.: EF321689368US :
For: VIDEO DESCRIPTION SYSTEM AND :
METHOD :
:

This is in response to applicant's "Petition Under 37 C.F.R. 1.47" filed 11 December 2001.

BACKGROUND

On 05 November 1999, applicant filed international application PCT/US99/26126, which claimed priority of an earlier United States application filed 06 November 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 05 June 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired on 06 May 2001.

On 04 May 2001, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 07 June 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 11 December 2001, applicant filed the present petition under 37 CFR 1.47(a) along with executed declarations.

On 26 December 2001, the DO/EO/US mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

DISCUSSION

A review of the application file reveals that the present petition had not been treated before the Notice of Acceptance was mailed.

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, the declarations filed 11 December 2001 are improper. Specifically, the declarations name an inventive entity different from that shown in the published international application. The DO/EO/US has not received a Notification of the Recording of a Change (Form PCT/IB/306) which states that inventors Alexandros Elefteriadis and Charlie Judice have been removed and that inventors John Smith and Lawrence Bergman have been added. In the absence of a Notification of the Recording of a Change (Form PCT/IB/306), a proper petition under 37 CFR 1.497(d) and the requisite processing fee must be submitted.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

The petition states that joint inventor Qian Huang cannot be located. The petition states that three attempts were made to contact Huang by postal mail and one attempt was made to reach Huang by telephone. Although it is apparent that the first two letters did not reach Huang because Huang was no longer employed at the delivery address, the petition does not state whether the third letter was successfully delivered. If the third letter was delivered to Huang, it would not be reasonable to assert that Huang cannot be located. Furthermore, the petition does not mention any additional attempts to locate Huang, e.g. by searching telephone directories, by trying to obtain a forwarding address, and by contacting Huang's former co-workers. Thus, it would not be reasonable to conclude at the present time that Huang cannot be found.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

The Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903) mailed 26 December 2001 is hereby VACATED.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459